

REMARKS

In response to the final Office Action dated May 2, 2008, Applicants have amended the claims, which when considered with the following remarks, is deemed to place the present application in condition for allowance. Favorable consideration and allowance of all pending claims is respectfully requested. The amendments to the claims have been made in the interest of expediting prosecution of this case. Applicants reserve the right to prosecute the same or similar subject matter in this or another application.

Claims 1-16 and 18-35 are pending in this application. By this Amendment, Claims 2-11, 18, 20, 24, 31 and 33 have been amended and Claims 1, 12-16, 19, 25 and 32 have been cancelled without prejudice. Claims 2-11, 18, 20-24, 26-31 and 33-35 are therefore now under examination. Of these claims, Claims 2-9 and 31 have been amended to depend from objected Claim 33. Claims 10 and 11 have been amended to depend from unrejected Claims 34 and 35, respectively. Claim 20 has been amended to (1) recite that the lubricating oil composition data is derived from a condition associate with an engine test and (2) delete the recitation "the plurality of different lubricating oil compositions have a phosphorous content at or below 0.08 wt. % and a sulfur content below 0.2 wt. %". Accordingly, Claim 20 is now believed to be substantially similar in scope to objected Claim 33 and therefore believed not to contain any new matter nor raise any new issues. Claim 33 has been amended to correct a perceived antecedent basis error. It is therefore respectfully submitted that no new matter has been added to this application nor have any new issues been raised by these amendments. Thus, entry and consideration of the subject Amendment is deemed appropriate as it places the application in condition for allowance.

The Examiner has objected to Claims 33-35 for the recitation "each of a plurality of different lubricating oil compositions" on line 6 of Claim 33 as lacking antecedent basis. Claim 33 has been amended in a manner as suggested by the Examiner and believed to obviate the objection. Therefore, withdrawal of the objection is respectfully submitted.

The Examiner has rejected Claims 1-16 and 18-32 under 35 U.S.C. §112, first paragraph, as failing to comply with the written description requirement. Of these claims, (1) Claims 1, 12-16, 19, 25 and 32 have been cancelled; (2) Claims 2-9 and 31 have been amended to depend from unrejected Claim 33; (3) Claims 10 and 11 have been amended to depend from unrejected Claims 34 and 35, respectively; and (4) Claim 20 has been amended to delete the recitation "the plurality of different lubricating oil compositions have a phosphorous content at or below 0.08 wt.% and a sulfur content below 0.2 wt. %." Accordingly, this rejection is deemed moot and withdrawal is respectfully requested.

The Examiner has provisionally rejected Claims 20 and 22-23 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over copending U.S. Application No. 10/699,510. Claim 20 has been amended to be substantially similar in scope to unrejected Claim 33. Accordingly, this provisional rejection is now deemed moot and withdrawal is respectfully requested.

Appln. No. 10/699,529
Amdt dated July 15, 2008
Reply to Office Action dated May 2, 2008

For the foregoing reasons, Claims 2-11, 18, 20-24, 26-31 and 33-35 as presented herein are believed to be in condition for allowance. Such early and favorable action is earnestly solicited.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Michael E. Carmen". The signature is fluid and cursive, with the first name "Michael" and last name "Carmen" clearly distinguishable.

Michael E. Carmen

Reg. No. 43,533

Attorney for Applicants

M. CARMEN & ASSOCIATES, PLLC
170 Old Country Road – Suite 400
Mineola, NY 11501
Phone: (516) 992-1848
Facsimile: (516) 739-0981
MEC:bg